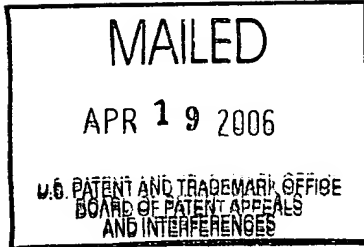


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID G. MCCARTHY

Appeal No. 2006-0159
Application 08/951,276¹

ON BRIEF

Before BARRETT, GROSS, and LEVY, Administrative Patent Judges.
BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-20.

We affirm-in-part.

¹ Application for patent filed October 16, 1997, entitled "Retractable Receptacle for Furniture."

PRIOR DECISION

A prior decision was entered by this panel in Appeal No. 2001-0076 on October 31, 2002, in which we reversed the examiner's rejection under 35 U.S.C. § 112, first paragraph, for lack of written description. In that case, the examiner had expressly withdrawn the rejections under 35 U.S.C. §§ 102 and 103 in the examiner's answer, so no prior art rejections were before us. The examiner has obtained permission to reopen prosecution after the Board decision.

BACKGROUND

The invention relates to a retractable receptacle for electronic or communications equipment mounted in a furniture unit, such as office conference tables.

Claim 1 is reproduced below:

1. In an article of furniture having a top surface and an opening defined in said top surface; the improvement comprising a receptacle unit adapted to be mounted in said opening in said top surface of said article of furniture; said receptacle unit comprising a top and at least one sidewall extending downwardly from said top, said at least one sidewall having at least one receptacle defined therein; and means for selectively displacing said receptacle unit between a retracted position in which said top of said receptacle unit is planar with said top surface of said article of furniture, and an extended position in which said at least one receptacle in said at least one sidewall of said receptacle unit is elevated above the top surface of said article of furniture.

THE REFERENCES

The examiner relies upon the following references:

Mitchell et al. (Mitchell)	4,511,198	April 16, 1985
Byrne	4,747,788	May 31, 1988

Mitchell discloses a pop-up receptacle unit in a housing mounted to an underside of a top surface of a piece of furniture in relation to an opening in the surface. The receptacle unit is spring biased and is held in either a retracted or extended position (Figs. 2 and 3). The opening 14 is formed with a recessed annular shoulder 16 so that a thin closure disk (not shown) can be placed thereon to provide an uninterrupted working surface 12 (col. 3, lines 64-68; Fig. 2). Only one receptacle is shown (Fig. 4), but it is disclosed that the housing 50 has receptacle openings at each side thereof (col. 4, lines 41-44).

Byrne discloses a manually operable retractable receptacle in a slot 102 in the top of a furniture work surface 104 having a veneer 106. A stationary upper housing 108 has vertical sides 112 and 114 and a horizontal collar 116 (col. 6, lines 53-62). The collar 116 overhangs the slot 102 with the lower surface of the collar 116 substantially flush with the veneer 106 to support the housing 108 (col. 7, lines 8-13). The power carriage 150 has a receptacle box 152 with a pair of receptacles 170 on one side and an upper cover plate 162 which fits essentially flush with the collar 116 when the receptacle box 152 is in the closed position (col. 8, line 65, to col. 9, line 1). A separate cover

plate 164 can be provided to cover part of the opening not covered by cover plate 162 and there can be a power cord opening 166 which may be covered with a set of flexible brushes 168 (Fig. 2; col. 9, lines 3-29). Byrne discloses that the receptacle box 152 could be double-sided (col. 9, lines 54-59).

We refer to the final rejection (pages referred to as "FR__") entered November 18, 2004, and the examiner's answer (pages referred to as "EA__") entered June 14, 2005, for a statement of the examiner's rejection, and to the appeal brief (pages referred to as "Br__") received March 3, 2005, and the reply brief (pages referred to as "RBr__") received June 23, 2005, for a statement of appellant's arguments thereagainst.

THE REJECTIONS

Claims 1-5 and 7-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Byrne and Mitchell. The examiner finds that Byrne discloses the top 162 of the receptacle "being 'substantially' planar with a top surface of the article of furniture (see col.7, lines 10-12)" (FR2), but not "planar." The examiner finds that Mitchell teaches a receptacle unit mounted in a housing on an underside of the top surface with a disk in a recess to provide an uninterrupted working surface and concludes that it would have been obvious "to modify the receptacle of Byrne by having the top of the receptacle being planar with a top

surface of the article of furniture so that the surfaces would be flush as taught by Mitchell et al." (FR3).

Claims 1, 2, 4-7, 10, 12-15, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitchell. The examiner finds that Mitchell discloses the claimed invention except for the top of the receptacle unit being planar with a top surface of the article of furniture. The examiner finds that Mitchell teaches a disk in a recess to cover the receptacle unit to provide an uninterrupted working surface and that it would have been within the general level of skill in the art to make plural parts unitary as a matter of engineering choice (FR4). The examiner concludes that it would have been obvious to modify the receptacle of Mitchell by making a one piece top such that the top of the receptacle unit would be flush with the top surface of the article of furniture to provide an uninterrupted surface (FR4).

DISCUSSION

Grouping of claims

The claims are grouped to stand or fall together with the independent claims.

Byrne and Mitchell

We interpret the "means for selectively displacing said receptacle unit" to be the structure for allowing the receptacle unit to be displaced, as opposed to the structure for actually

causing the movement, such as a spring. Appellant does not contest that Byrne has means for selectively displacing the receptacle unit.

Claim 1 is taken as representative. Claim 16 differs from claim 1 in reciting a "plurality of sidewalls ... each of said sidewalls being recessed inwardly relative to the top of said receptacle unit" instead of "at least one sidewall" in claim 1, and claim 16 does not require any receptacle, whereas claim 1 requires "at least one receptacle."

Appellant argues that independent claims 1, 16, and 19 each define a device in which a top surface of a receptacle is planar with the top surface of an article of furniture in which the receptacle is mounted when the receptacle is in its retracted position and that this is not taught or suggested by the prior art, alone or in combination (Br8). It is argued that the top of the Byrne housing is above the top surface of a work surface in which the housing is mounted when the housing is in a retracted position. It is argued (Br9):

Modification of the Byrne patent, such that the top surface of the collar 116 is flush with the working surface 104 so that the top surface of the collar 116 is planar with the top of the working surface, would defeat the intended purpose and express objective of the arrangement of structure disclosed by Byrne, namely to enable the bottom surface of the collar 116 to provide a supporting surface for the housing 108 by permitting the outer perimeter of the collar 116 to overhang the slot 102.

It is argued that Mitchell does not teach or suggest an arrangement by which the top of a housing is planar with the top surface of a working surface when the housing is in a retracted position because Mitchell discloses that the top surface of the housing 50 is recessed below the top of a working surface 12 when the housing is in its retracted position and it is necessary to provide a removable closure element (a disk) over the opening to provide an uninterrupted work surface, which is distinctly different from the structural arrangement in claim 1 (Br10). It is argued that the only suggestion for the proposed modification is in appellant's own disclosure, which is improper (Br10-11).

The examiner responds (EA6): "Byrne discloses the invention substantially as claimed except for the surfaces being uninterrupted. The top of Byrne could/would fit in the recess 16 taught by Mitchell to provide an uninterrupted surface." The examiner states that as long as hindsight does not include any knowledge from applicant's disclosure, it is proper, citing In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971) (EA6).

Appellant replies (RBr2): "[T]he structure disclosed by the Byrne patent is arranged to enable the bottom surface of a collar 116 to provide a supporting surface for the housing 108 by permitting the outer perimeter of the collar 116 to overhang the slot 102. Therefore, providing Byrne with a top surface of the collar which is flush with the working surface would defeat the

intended purpose and express objective of the arrangement of structure disclosed by Byrne." It is also argued (RBr2): "Even if the Examiner's conclusion that the top of Byrne could/would fit in the recess taught by Mitchell to provide an uninterrupted surface, this is not the standard by which patentability is determined.... The only issue to be determined is if there is a suggestion or motivation in the prior art to combine the references as proposed by the Examiner in the final action." It is argued that there is no motivation in the prior art itself and the only basis for the combination must come from the improper use of appellant's own disclosure (RBr4).

The rejection could have been better stated. The statement that "[t]he top of Byrne could/would fit in the recess 16 taught by Mitchell to provide an uninterrupted surface" (EA6) does not clearly state the modification and improperly words the motivation. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992) (citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). The examiner's rote citation of McLaughlin does not answer the motivation issue. Nevertheless, we think it is apparent that what the examiner was trying to get at was that it

would have been obvious to one of ordinary skill in the art to recess the collar 116 of Byrne in the working surface so that the top of the collar 116 and cover plates 162 and 164 are level with the working surface given the teachings in Mitchell of a disk in a recess to provide an uninterrupted working surface when the receptacle is retracted. Thus, the motivation for the modification is found in Mitchell's teaching of providing a planar working surface when the receptacle is retracted and its solution of mounting the cover for the hole in a recess. This is similar to the well known technique of countersinking so that a flat-head screw is flush with the surface. We do not agree with appellant's argument that there is no motivation in the references because Mitchell expressly teaches that there should be an uninterrupted surface when the receptacle is retracted. We also do not agree with appellant's argument that providing a collar top surface flush with the working surface would defeat the intended purpose and objective of Byrne since the bottom of the collar would still support the housing 108. For these reasons, we affirm the rejection of claims 1-5 and 7-18.

Mitchell

In regard to the rejection of claim 1 over Mitchell alone, appellant argues that in Mitchell it is necessary to put a removable cover element (a disk) over the opening to provide an uninterrupted work surface, whereas claim 1 recites that the top

surface of the housing itself, when in its retracted position, is planar with the top surface of an article of furniture to provide an uninterrupted top working surface (Br11). Thus, it is argued, that "[a]pplicant's claimed article of furniture eliminates the need to provide a [sic] separate structural elements (a removable cover, an annular shoulder to support the removable cover), for providing an uninterrupted top working surface when the housing is in its retracted position" (Br11). It is argued that there is no motivation to modify Mitchell to render claim 1 obvious. It is argued that modification of Mitchell is not simply making plural parts unitary, since the housing 50 and the removable cover serve different functions and Mitchell provides a recessed annular shoulder 16 around the opening 14 solely to support the removable cover, but would require (1) providing a housing arranged so that the top surface is planar with a working surface when the housing is in its retracted position, (2) elimination of the removable closure element, and (3) eliminating the annular shoulder 16 (Br12). Appellant concludes that the structure in Mitchell is distinctly different from the structure of claim 1 (Br13) and the same arguments apply to claim 19 (Br13-14).

The examiner responds to the statement at Br13 by stating that (EA7): "Applicant's arguments do not clearly point out the patentable novelty which he thinks the claims present in view of the state of the art disclosed by the references cited or the

objections made. Further, they do not show how the claims avoid such references or objections."

Appellant replies that the structural differences are discussed at page 11 of the appeal brief and the examiner fails to respond to these specific arguments (RBr5).

We agree with appellant that the rejection does not account for the structural differences between claims 1 and 19 and Mitchell, which appellant has expressly pointed out. As noted by appellant, simply making the disk and the housing unitary will not produce the claimed invention. The user has to be able to depress the housing 50 to allow the spring and ratchet mechanism to work (Fig. 7), somewhat like the operating mechanism for a retractable ball point pen. If the disk were fixed to the top of the housing, the disk would need to be made correspondingly smaller and the annular shoulder 16 would be unnecessary, which modifications have not been addressed by the examiner's statement of the rejection. Mitchell is a good reference because it shows a housing mounted to the underside of a top surface of a piece of furniture, as recited in claim 16, and the housing receives a receptacle unit which has mechanical means (a spring) to selectively displace the receptacle unit. What is missing is the top of the receptacle unit being planar with the top surface of the article of furniture and we do not find this teaching or suggestion in Mitchell alone. Accordingly, the examiner has

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failed to establish a prima facie case of obviousness. The rejection of claims 1, 2, 4-7, 10, 12-15, 19, and 20 is reversed.

Citation of other prior art

This panel cites the following additional prior art as relevant to the claimed subject matter, especially to the limitation of the top of the receptacle being planar with the top surface of the article of furniture:

Cole	3,646,244	February 29, 1972
Propst et al. (Propst)	4,372,629	February 8, 1983
Lecreux et al. (Lecreux)	5,888,078	March 30, 1999
	(\$ 102(e) date December 9, 1996)	

Cole, Propst, and Lecreux all deal with retractable receptacles and, therefore, are analogous prior art.

Cole and Propst are mentioned in Byrne, which provides motivation for a combination. Cole discloses a retractable floor receptacle. "[T]he movable housing 10 with the cover plate 22 attached on the upper end thereof can slide vertically within the stationary casing 16 to either its hidden position flush with the level of the floor as illustrated by FIGS. 1 and 2 or to its withdrawn position above the level of the floor as illustrated by FIGS. 3 and 4" (col. 4, lines 7-12). Thus, Cole discloses a receptacle unit where the top of the receptacle unit is planar with the top surface when in the retracted position.

Propst discloses a cover 22 hinged to a vertical back panel of a piece of furniture with receptacles mounted to the lower

portion of the cover. Propst discloses that "[d]esk top 13 and cover 22 comprise a uniform planar surface interrupted only by brush 40" (col. 4, lines 53-55). Thus, Propst discloses a receptacle unit where the top of the receptacle unit is planar with the top surface when in the retracted position.

Lecreux describes a retractable service unit for the supply of energy or fluids. The unit includes a protective box preferably adapted to be sunk in the ground and a casing 14, having current outlets 16, which is raised by lifting means 30 (col. 3, first paragraph). The external surface of the cover 26 contains material suitable to the surroundings of the box and is planar with the surface (Fig. 1).

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CONCLUSION

The rejection of claims 1-5 and 7-18 is affirmed.

The rejection of claims 1, 2, 4-7, 10, 12-15, 19, and 20 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED - IN - PART

Lee E. Barnett

LEE E. BARRETT
Administrative Patent Judge

Anita Pellman Gross

ANITA PELLMAN GROSS
Administrative Patent Judge

Thos. A. Levy

STUART S. LEVY
Administrative Patent Judge

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